

REMARKS

In the Final Office Action, claims 1-11, 13-15, and 17-27 were rejected. By the present Response, Applicants submit declarations pursuant to 37 C.F.R. § 1.131 to remove Siegel, U.S. Patent No. 7,149,353 (hereinafter “Siegel”) as prior art. Further, pursuant to M.P.E.P. § 715.09(D), it is Applicants’ understanding these declarations will be considered as timely submitted in view of the concurrently filed Request for Continued Examination. In view of the following remarks and appended evidence, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Final Office Action, claims 1-7, 10, 13, 14, 19, 20, 22, 23, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Ittner, U.S. Patent No. 5,664,027 (hereinafter “Ittner”). Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Ittner, and further in view of Wilks et al., U.S. Patent No. 5,568,571 (hereinafter “Wilks”). Claims 8, 11, 15, 17, 18, 21, 24, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Jordan, U.S. Patent No. 6,823,203 (hereinafter “Jordan”), and further in view of Ittner. Applicants respectfully traverse these rejections. In particular, Applicants submit that the following remarks and the appended evidence are sufficient to demonstrate prior invention with regard to Siegel, which is the primary reference relied upon by the Examiner in rejecting all of the pending claims.

Prior Invention with Regard to Siegel

To establish prior invention, an applicant must present a “showing of facts [that] shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” 37 C.F.R. §1.131(b). Applicants respectfully submit that such a showing is made by the appended declarations under Rule 131, and the accompanying exhibits.

On its face, Siegel has an actual filing date of September 23, 2003. Accordingly, the earliest possible date upon which the Siegel may be relied for a rejection is September 23, 2003. Applicants respectfully submit that the accompanying Rule 131 declarations establish conception of the subject matter disclosed and claimed in the present invention prior to September 23, 2003, coupled with diligence up to the time of filing of the instant application on November 26, 2003. Specifically, the accompanying declarations include the declarations under 37 C.F.R. § 1.131 of Yaseen Samara and Vijaykalyan Yeluri, co-inventors of record for the present application, and of the undersigned, Patrick S. Yoder, as the attorney who prepared and filed the present application. It should be noted that the Rule 131 declarations of Messrs. Samara and Yeluri, referred to herein as the “Samara Declaration” and the “Yeluri Declaration,” respectively, set forth substantially identical facts and evidence and, therefore, will be discussed together below.

As indicated in the Samara and Yeluri Declarations, the subject matter disclosed and claimed in the above-referenced patent application was conceived of prior to September 23, 2003. This is evidenced by an e-mail communication between Mr. Yoder and Mr. Samara dated August 19, 2003, relevant portions of which are attached to each the Samara and Yeluri Declarations as Exhibit A. *See* Samara and Yeluri Declarations, paragraph 4. Specifically, in the communication set forth in Exhibit A of the Samara and Yeluri Declarations, Mr. Yoder contacted Mr. Samara and Mr. Prakash Mathew, another co-inventor of record, to inform them that he was in the process of preparing the above-referenced application. *See id.* at Exhibit A. Thus, Applicants submit that Exhibit A demonstrates that preparation of the present application commenced at least as early as August 19, 2003, and that any disclosure of the invention (e.g., by way of disclosure documents, inventor interviews, etc.) to the drafting attorney also occurred at least as early as that date. Accordingly, Applicants submit that the subject matter disclosed and claimed in the above-referenced application was *clearly* conceived prior to the filing of Siegel on September 23, 2003. Further, it should be noted that the conception of the present invention occurred in the United States. *See id.* at paragraph 6.

Applicants further submit that diligence was exercised by the inventors and by Mr. Yoder from prior to September 23, 2006 to the filing of the present application on November 26, 2003. Referring now to the declaration of Mr. Yoder under 37 C.F.R. § 1.131 (hereinafter the “Yoder Declaration”), Applicants submit that prior to September 23, 2003, the law firm of Fletcher Yoder, where Mr. Yoder was then and is presently employed, was engaged for the preparation and filing of the above-identified application. *See* Yoder Declaration, paragraph 4. Upon engagement of Fletcher Yoder, the above-identified application was duly docketed for preparation in the ordinary course of business. As summarized above, Mr. Yoder sent an e-mail communication to Messrs. Mathew and Samara on August 19, 2003 stating that the preparation of the present application was in progress. *See* Yoder Declaration, paragraphs 5-6. A redacted copy of this e-mail communication is attached to the Yoder Declaration as Exhibit A, and is substantially identical to Exhibit A of the Samara and Yeluri Declarations discussed above. Thus, Applicants submit that the preparation of the present application by Mr. Yoder began *prior* to September 23, 2003.

On November 15, 2003, Mr. Yoder sent an e-mail communication containing a first draft of the above-identified application to Messrs. Mathew and Samara for review. *See id.* at paragraph 7. A set of formal papers, including assignment and declaration forms, were also sent in conjunction with the first draft. *See id.* A redacted copy of this e-mail is provided as Exhibit B of the Yoder Declaration. As set forth in Exhibit B, Mr. Yoder requested that the inventors review, provide feedback, and return the executed formal papers by November 24, 2003. *See id.* at Exhibit B. Upon receiving the executed formal papers from each of the inventors, Mr. Yoder filed the above-identified application on November 26, 2003. *See id.* at paragraph 8.

As set forth in Section 2138.06 of M.P.E.P., *reasonable diligence* is all that is required of the attorney, and is established if attorney worked reasonably hard on a particular application during the continuous critical period. *See Bey v. Kollonitsch*, 866 F.2d 1024, 231 U.S.P.Q. 967 (Fed. Cir. 1986). If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. *See id.* Indeed, the Board of

Patent Appeals and Interferences has noted that reasonable diligence does not require that “an inventor or his attorney ... drop all other work and concentrate on the particular invention involved.” *See Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. App. & Inter. 1974). Under the present set of facts, the relevant critical period would run from just prior to September 23, 2003 (the filing date of Siegel) to the filing of the present application on November 26, 2003. As stated in the Yoder Declaration, the present application was duly docketed by Fletcher Yoder prior to September 23, 2003 for preparation in the ordinary course of business and was in fact prepared in the ordinary course of business, as evidenced by the filing of the present application on November 26, 2003. Thus, Applicants respectfully submit that the evidence set forth in Exhibits A and B of the Yoder Declaration coupled with the fact that the disclosure of the invention was communicated by the inventors to Mr. Yoder prior to September 23, 2003, as discussed above, are sufficient to demonstrate diligence by both the inventors and the drafting attorney from prior to September 23, 2003 and through the filing of the present application on November 26, 2003.

Based on the above facts, Applicants respectfully assert that a showing has been made that the invention disclosed and claimed in the present patent application was made *prior* to September 23, 2003, and that diligent efforts were made from *prior* to September 23, 2003 through the filing of the present application. Therefore, Applicants respectfully submit that prior invention has been demonstrated with respect to Siegel. Thus, Siegel cannot be considered as prior art with regard to the present application.

Deficiencies of the Rejection

As noted above, the Examiner rejected all of the pending claims under Section 103 in the present Office Action relying on Siegel as a primary reference. Applicants further note that in setting forth these Section 103 rejections, the Examiner admitted that Siegel fails to disclose several features recited by the pending claims, and thus further relied on one or more of Ittner, Wilks, or Jordan as secondary references to cure the deficiencies of Siegel. However, in view of the above discussion, Siegel cannot be considered as prior art with regard to the present

application and, therefore, cannot be applied in the instant Section 103 rejections. Therefore, absent the availability of Siegel as prior art, Applicant submit that Ittner, Wilks, or Jordan references, taken alone or in combination, cannot anticipate or render obvious the pending claims. As such, Applicants respectfully request that the Examiner remove Siegel from consideration, withdraw the outstanding Section 103 rejections, and allow the pending claims.

Claim Rejections Under 35 U.S.C. § 101

In the Final Office Action, the Examiner maintained the rejection claims 25-27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner stated that “[c]laims 25-27 recite an ‘image … stored on computer-readable medium,’ which does not impart *functionality* to a computer or computing device, and is thus considered nonfunctional descriptive material.” *See* Final Office Action, page 3. (Emphasis in original.) Applicants respectfully traverse this rejection.

As discussed in a previously filed Response, Applicants assert that the images recited by claims 25-27 are not intended to impart functionality to a computer or computing device, as alleged by the Examiner. *See* Response to Office Action Mailed June 26, 2007, pages 9-10. Rather, claims 25-27 are meant to be interpreted as *product-by-process* claims in accordance with Section 2173.05(p) of the M.P.E.P which states that “a product-by-process claim, which is a product claim that *defines the claimed product in terms of the process by which it is made*, is proper.” *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 U.S.P.Q. 145 (CCPA 1969); *In re Steppan*, 394 F.2d 1013, 156 U.S.P.Q. 143 (CCPA 1967). (Emphasis added.) With the foregoing guidelines in mind, Applicants reiterate that the “images” recited by claims 25, 26, 27 are not, as alleged by the Examiner, meant to impart functionality to a computer, but rather are the *resulting product* created by the processes recited by independent claims 1, 10, and 15, respectively. Moreover, Applicants submit that the claimed images of claims 25, 26, and 27 can *only* be defined by their associated processes.

The M.P.E.P. further states that “the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” M.P.E.P. § 2113. (Emphasis added.) With this in mind, Applicants respectfully submit that one skilled in the art would *expect* that a resulting image produced by the processes set forth in independent claims 1, 10, and 15 to be stored on some tangible medium. Further, Applicants note that each of claims 25-27 *explicitly* recite that the resulting image is stored on a computer readable medium. Thus, claims 25-27 are not directed solely towards an arrangement of data itself, but clearly specify that the data is embodied on a tangible medium.

Applicants further contend that the resulting images of claims 25-27 are different from those obtained in the prior art due to the novel method of selectively obfuscating indicia in the resulting image, as set forth in the disclosure of the present application. *See* Application, pages 1-2. Moreover, the resulting images, created due to the efficient and automated removal of sensitive data, are particularly useful in a medical context in which legal and ethical considerations govern that sensitive information should not be stored, shared, or transmitted. *See id.* at page 2. Accordingly, Applicants submit that the resulting images recited by claims 25, 26, and 27 are the useful, concrete, and tangible resulting product produced by the processes recited by claims 1, 10, and 15, respectively, thus constituting statutory subject matter under Section 101. For at least these reasons, Applicants respectfully request withdrawal of the Section 101 rejections and allowance of claims 25-27.

Conclusion

In view of the foregoing evidence and the remarks set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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